

places, in claim 7 as originally filed. To the extent that claim 7 has been rejected, claims 14 and 15 should be deemed allowable for the same reasons as claim 7 set forth below.

Care has been taken so that no new matter has been introduced into this application. With the exception of the deletion of non-elected subject matter, these amendments are not intended to alter the scope of the claims.

## **II. Restriction Requirement**

The restriction requirement of record has been made final, on the ground that the claims lack unity of invention. See Office Action at pages 2-3. While Applicants maintain their traverse of this requirement, they affirm their election with traverse of Group IV, now claims 1-7 and 9-15, drawn to compounds, compositions, and methods of use for Formula I wherein Z is =CH-. Accordingly, and without prejudice or disclaimer, the claims have been amended to exclude non-elected subject matter. Specifically, claim 1 no longer recites that Z can be a nitrogen atom.

## **III. Rejections Under 35 U.S.C. §112, ¶2**

Claims 1-7 and 9-13 have been rejected under 35 U.S.C. § 112, ¶2, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter Applicants regard as their invention. See Office Action at page 4. Applicants respectfully traverse, and respond as follows.

A. In the definition of group B, the claim language "heteroaryl group which may be substituted or unsubstituted and is optionally fused with a benzene ring" has been rejected for being indefinite. Applicants respectfully disagree with the rejection.

Claim 1, reciting the definition of group B, is not indefinite. The claim language satisfies the two separate requirements of 35 U.S.C. § 112, ¶ 2. First, "the claims must set forth the subject matter that applicants regard as their invention." MPEP § 2171. Second, "the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant." *Id.*

[b]readth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

MPEP § 2173.04 (citations omitted). Applicants contend that the rejected claim language is broad, but it is not indefinite.

Applicants give specific, but nonlimiting, examples of the heteroaryl group, heteroaryl group fused with a benzene ring, and optional substituents, on pages 7-8 in the specification. Taking the disclosure as a whole and these examples, one of ordinary skill in the art would be able to determine the metes and bounds of the claimed invention. B may be, for example, pyridopyrimidinyl; and B may not be a hydrogen atom.

To require the claims to list every single heteroaryl group would be to deprive the Applicants of substantial value of their invention. An unscrupulous copyist could easily select a heteroaryl group not listed, and thereby steal the essence of Applicants'

invention without fear of infringement. For these reasons, Applicants respectfully request that this rejection be withdrawn.

B. Claims reciting, "an amide derivative" have been rejected for being indefinite. See Office Action at page 4. Without acquiescing in the allegation that the claims were indefinite, Applicants have amended the claims to conform to the Examiner's suggestion. The claims now recite, "a compound of formula (I)" or similar language where appropriate. Applicants therefore request that this rejection be withdrawn.

C. The term "optionally" has been rejected for being indefinite. See Office Action at page 4. Applicants respectfully assert that "optionally" is not an indefinite term *per se*, and that the claim as it was written, was not indefinite. See MPEP § 2173.05(h)(III). One possible alternative expression is "ring B . . . is not fused or is fused with a benzene ring." Applicants assert that the present expression employing "optionally" is clear and satisfies 35 U.S.C. § 112, ¶2, discussed above. Applicants respectfully request that this rejection be withdrawn.

#### **IV. Claim Rejections Under 35 U.S.C. § 103**

Claims 1-7 and 9-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schromm et al.* (US 5,223,614). See Office Action at page 5. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness,

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2143. The present rejection falls short of establishing a *prima facie* case, at least because *Schromm et al.* fails to teach or suggest all of the claim limitations.

*Schromm et al.* shows a generic formula containing, among other radicals, a radical Q. See *Schromm et al.* at col. 1, line 30. "Q represents a substituted phenyl group[.]" *Id.*, at col. 1, line 36. Throughout the disclosure of *Schromm et al.*, this substituted phenyl group shows an hydroxyl or an ether substitution on the phenyl ring corresponding to radical Q. This hydroxyl or ether substitution does not teach or suggest Applicants' claimed invention. In present claim 1, to the extent that the ring comprising Z and binding R<sup>2</sup> remotely corresponds to *Schromm's* radical Q, the two structures differ: Applicants' "R<sup>2</sup> is a hydrogen atom or a halogen atom," not an hydroxyl or ether radical. The Office Action provides no motivation to modify *Schromm's* substituted phenyl group Q to obtain anything resembling Applicants' Z ring and R<sup>2</sup>. Even if such modification were made, no reasonable expectation of success can be shown that such molecules would work for *Schromm's* intended purpose. Therefore, Applicants respectfully request that the rejection be withdrawn as to all claims rejected.

**CONCLUSION**

Applicants respectfully request that all rejections be withdrawn, the application be reconsidered, and the claims allowed in a timely manner.

Please grant any extensions of time required to enter this response and charge any required extension fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Enclosure:

- Appendix